

U.S. Patent Application No.: 09/788,646  
Attorney Docket No. 52493.000127

### REMARKS

The Office Action dated July 21, 2009, has been received and carefully considered.

Claims 1-3, 7, 8, 12-14, 16, 53, 54 and 56-58 are pending in the application. By this response, claims 1, 54 and 56 are amended. Claims 21-24, 28-30, 35 and 55 are canceled without prejudice or disclaimer to the subject matter set forth therein.

Claim 56 is amended to further recite features of Applicants' claimed invention.

No new matter has been introduced by this Amendment, as support for the claim amendments can be found in the present application in paragraphs 0014-0021, 0028-0031, 0034 and in the drawings, for example.

Applicants respectfully request reconsideration and allowance of the pending claims in view of the following remarks and the above amendments.<sup>1</sup>

A. The Previously Allowed Subject Matter

In paragraph 2, the Office Action asserts that the Examiner withdraws the allowable subject matter of claims 54 and 55 because of the 101 and 112 second paragraph rejections.

Applicants note that previously claims 54 and 55 had been allowed, and claims 3 and 23 indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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<sup>1</sup> As Applicants' remarks with respect to the rejections in the Office Action are sufficient to overcome such rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

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Applicant requests clarification as to the basis for withdrawing the allowability of such claims based solely on grounds of 35 U.S.C. 101 and 112.

B. The Rejection under 35 U.S.C. § 101

In the Office Action, claims 1, 54 and 56 are rejected under 35 U.S.C. 101.

The Office Action asserts that such claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the key limitations in the claims are not tied to an apparatus or a machine. The Examiner suggests including some type of machine or apparatus in the key limitations. The Office Action further sets forth asserted basis for the 35 U.S.C. 101 rejection.

In order to expedite prosecution of this patent application, Applicant has amended the claims to further satisfy 35 U.S.C. 101 and in response to the comments in the Office Action. Based on such amendments and Applicants' remarks, withdrawal of the 35 U.S.C. 101 is respectfully requested.

Applicants welcomes the Examiner's further thoughts regarding how to even further satisfy the requirements of 35 U.S.C. 101.

C. The Rejection under 35 U.S.C. § 112

In the Office Action, claims 21-24, 28-30, 35, and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action sets forth asserted basis for the 35 U.S.C. 112 rejection.

In order to expedite prosecution of this patent application, Applicants have canceled such claims. Based on such amendments and Applicant's remarks, withdrawal of the 35 U.S.C. 112 is respectfully requested.

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D. The 35 U.S.C. §103 Rejection Based on Bennett In View of Hanby

In the Office Action, claims 1-3, 7, 8, 12-14, 16, 21-24, 28-30, 35, 53-58 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent 7,117,170 to Bennett *et al.* ("Bennett") in view of U.S. Patent 7,143,051 to Hanby *et al.* ("Hanby"). Applicants respectfully traverse this rejection for at least the following reasons.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. In *re* Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or "secondary considerations," of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); see also *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). An "expansive and flexible approach" should be applied when determining obviousness based on a combination of prior art references. *KSR*, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. *Id.* at 1741. Rather, there must still be some "reason that would have prompted" a person of ordinary skill in the art to combine the elements in the specific way that he or she did. *Id.*; In *re* Icon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. *KSR*, 127 S. Ct. at 1740-41.

Applicants respectfully submit that the Office Action fails to address every feature of independent claim 1. Specifically, Applicants submit that the Office Action fails to address "accessing at least one web page of a broker by inputting a broker network address," as recited in

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independent claim 1, and the interrelated features. Applicants respectfully submit that in order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations, or provide sufficient motivation to modify the references to arrive at the claimed invention. *See* M.P.E.P. § 2142 *et seq.*

The Office Action sets forth the basis of the 35 U.S.C. 103 rejection on pages 7-6.

Specifically, the Office Action asserts as to Bennett:

As per claims 1, 6, 16, 21, 23, 24, and 54-56, Bennett discloses a dedicated terminal 1003 at which data is exchanged. As such, it discloses providing sales-related data over a network (SHIPPING OR BUY/BIDDING), the sales related data being transmitted from a supplier (iShip) to a broker (shipper PC 1003) and being customized for the broker (user enters provider's system through a **hypertext e-mail link**), accessing at least one web page of a broker by inputting a broker network address (read as: Each Shipper, using a client computer device, accesses the System over a global communications **network** such as the Internet); receiving at a supplier a request for sales-related data from a user associated with a broker (user uses the computer of the broker to get nearest shipping location based on **e mail address**), the request for sales related data input from a broker network address being utilized for the transmission of the request for sales related data (see, column 20, line 42, shipping center data defaults to preset origin **zip code locations** based on **e-mail address** recognized at log on); accessing broker information of the supplier, using the broker network address to retrieve broker information from a broker information database (ship center database is accessed for shipping location); displaying to the user at least a portion of the broker information with at least a portion of related information (system displays the location of nearest shipping location, column 20); receiving at the supplier request-related information from the user (user sends weight of package information to system).

(emphasis added)

The Office Action further asserts:

But Bennett does not explicitly disclose insurance based inquiry system and thus does not explicitly disclose accessing state related information that includes at least one of the users' state of residence and the state in which the broker is licensed and generating the sales-related data based on the received request-related information based on the state related information, and including broker contact information.

The Office Action goes on to assert that Hanby cures the deficiencies of Bennett.

Applicant submits that the assertions in the Office Action, regarding the teachings of Bennett, mischaracterize such teachings and fail to support the 35 U.S.C. 103 rejection. That is,

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Bennett fails to teach or suggest "accessing broker information, at the supplier, **using the broker network address** to retrieve broker information from a broker information database," as is recited in amended claim 1. (emphasis added). Nowhere does Bennett disclose, or suggest, a relationship in which a user inputs a broker network address to access a broker web page, and **that same broker network address** is subsequently sent to and used by a supplier to retrieve broker information from a broker information database. Claim 1 recites such a relationship, and Applicants respectfully submit that Bennett fails to teach or suggest such claimed relationship of the broker network address.

The Office Action appears to interpret various parameters of Bennett as the claimed "broker network address." That is, the assertions in the Office Action (as set forth above) appear to allege that the claimed "broker network address" is constituted by a hypertext e-mail link; access over a network; e-mail address; and/or zip code locations. (See emphasized text above). Applicant submits that it is improper to pick and choose such multiple parameters - so as to allege teaching Applicants' "broker network address" and the manipulation thereof. In other words, it appears the Office Action is attempting to rely on multiple parameters of Bennett to teach Applicant's single parameter (i.e., the broker network address). Such fails to support the 35 U.S.C. 103 rejection.

Applicant notes in particular the relied upon portion of Bennett in column 20, lines 37-44. Therein, Bennett describes:

If the Shipper is Logged On to the System and has established an account, the System will default the Shipping Location to the Shipper's specified Preferences which the Shipper inputs (not shown) the first time that the Shipper logs into the System. If the Shipper's specified Preference is a "customer drop off" location, the System populates the Origin Zip Code with the Shipper's default Zip Code which the Shipper inputs (not shown) the first time that the Shipper logs into the System.

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Applicant submits that such disclosure in and of itself reflects the fundamental differences between the claimed invention and Bennett. Such disclosure merely teaches logging on to an account and subsequent processing. Such disclosure fails to teach the claimed manipulation of the broker network address, as recited in claim 1, and fails to support the rejection.

Applicant submits that Bennett fails to support the alleged teachings relied upon in the Office Action for at least the above reasons, as well as the reason set forth in the February 6, 2009 Response.

Applicants understand that the Office Action and the 35 U.S.C. 103 rejection relies collectively on the teachings of Bennett and Hanby. The Office Action asserts that Bennett discloses the invention as set forth above but fails to disclose an insurance based inquiry system and other features. However, even if Bennett was so modified as proposed in the Office Action (which is not admitted to be obvious), Hanby fails to cure the deficiencies of the teachings of Bennett, as discussed above. In particular, Hanby fails to disclose the particulars relating to the manipulation of the broker network address, as discussed above.

Accordingly, Applicants respectfully submit that claim 1 defines patentable subject matter for at least the reasons set forth above. Further, Applicants respectfully submit that independent claims 54 and 56 define patentable subject matter for reasons similar to those set forth with respect to claim 1.

The various dependent claims define patentable subject matter based on their various dependencies on the independent claims, as well as the additional features such dependent claims recite. Withdrawal of the rejection under 35 U.S.C. §103 is respectfully requested.

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In view of the foregoing, Applicants respectfully submit that the 35 U.S.C. 103 rejection be withdrawn.

E. Conclusion

In view of the foregoing amendments and arguments, Applicants respectfully submit that this application is in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

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It is believed that no fees are due for filing this Amendment. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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